

REMARKS

Appreciation is hereby expressed to Examiners Alysia Berman and Diana Dudash for the interview so courteously granted on July 18, 2001. Appreciation is also expressed to Examiner Berman for her assistance in locating and furnishing to the undersigned a copy of an article entitled "Cigarette Smoke Induced Lipid Peroxidation And Its Oxidative Effect On The Skin" which is the basis for the abstract of same cited as prior art in the present case.

Claim 17 has been amended to more definitely set forth the invention and obviate the rejection. The present amendment is deemed not to include new matter. Claims 11 and 17-19 remain in the application. Reconsideration is respectfully requested of the rejection of Claims 17-19 and 11 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 17 has been amended to obviate the rejection, and it is believed that the rejection is now moot. Withdrawal of the rejection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of Claims 11 and 17-19 under 35 U.S.C. § 102(b) as being anticipated by US 5,601,806 (806). The present invention relates to a means to treat stress due to floating fine particles which float in the air and have adverse effects on the skin (specification, page 3, lines 21-25). This environmental stress is believed to be caused by various chemical and/or physical factors such as oxidation reactions triggered by the contact between floating fine particles

in the skin although there may also be an influence due to psychological factors such as psychological stress due to mere contact with floating fine particles (specification, page 4, lines 3-9).

The inventors of the present application conducted an in-depth investigation and unexpectedly discovered that certain antioxidants have the effect of effectively treating the adverse effects of environmental stress on the skin, and that skin can be adversely treated for environmental stress by using a liniment which contains antioxidants (specification, page 4, last paragraph).

The floating fine particles which cause environmental stress are those which are mainly generated by artificial causes such as tobacco smoke and automobile exhaust (not only from gasoline engines but also from diesel engines) as well as soot and smoke from chemical plants and thermal power plants (specification, page 6, lines 12-18). Applicants conducted testing on skin to determine the effects of environmental stress using tobacco smoke and exhaust gas for the purpose of determining what, if any, effect floating fine particles would have on the skin (specification, page 17, lines 9-25).

These tests made it clear that, in a stressful environment, relatively long-term contact with the skin by floating fine particles causes adverse effect on conditions of the skin. These tests made it clear that when a stressful environment occurs (1) the skin is exposed to the stressful environment and frequently

comes into contact with floating fine particles, and (2) that aggravation of appearance such as rough skin, lackluster skin and reddening and/or some adverse effects such as a reduction in the cornea moisture content are observed (specification, page 19, lines 7-19).

In the rejection the Examiner indicates that in order to treat or prevent skin damage such as wrinkles or premature aging would inherently suppress ultraweak chemiluminescence as instantly claimed. Claims 11 and 17-19 have been amended to make it clear that the method is for treating environmental stress due to exposure of skin to automobile exhaust gases.

The '806 patent to Katsumata, et al. is concerned only with providing a prophylactic and/or therapeutic agents to the skin to reduce skin damage due to light radiation (light rays or ultraviolet rays) by applying to the skin an aminothiosulfonic acid compounds. However, there is no disclosure whatever in the Katsumata, et al. reference that exposure of the skin to automobile exhaust gases (floating particles) produces environmental stress of the skin or that applying to the skin a liniment containing thiotaurine could be used to treat the skin for this environmental stress. On the contrary, that teaching or suggestion comes only from the present application and constitutes an important element or aspect of the present invention.

In relying upon a theory of inherency, the Examiner is required to provide a basis in fact and/or technical reasoning to

reasonably support the determination that the alleged inherent characteristics necessarily flows from the teachings of the prior art. Ex parte Levy, 17 USPQ 2d 1461 (BPAI, 1990).

In the present case, the Examiner has provided no basis in fact and/or technical reasoning to support the conclusion that one of ordinary skill in the art would conclude that the presence of floating particles in the air, such as from exhaust gases, would have an environmental stressful factor on skin and cause the same damage to skin as light or ultraviolet rays.

Moreover, the Examiner has failed to provide a basis in fact and/or technical reasoning to support the conclusion that the taurine analog that is disclosed in the Katsumata, et al. reference would function in a way to effectively treat environmental stress of the skin due to these exhaust gases. For this reason, it is respectfully submitted that the rejection fails, as a matter of law, in view of the above authority. Consequently, the Examiner would be justified in no longer maintaining this rejection.

Reconsideration is respectfully requested of the rejection of Claims 11 and 17-19 under 35 U.S.C. § 103(a) as being unpatentable over US 5,601,806 (806) in combination with HCAPLUS extract of Egawa, et al., "Cigarette smoke induced lipid peroxidation and its oxidative effect on the skin", Sci.Conf.Asian Soc. Cosmet. Sci., 3rd (1997):271-278.

The deficiencies of the '806 Katsumata, et al. reference are discussed above.

The Egawa, et al. reference appears to have been written by three of the inventors of the present invention and the abstract fails to list a complete date. The only indication of the date of publication on the abstract appears to be that it was published in 1997 third. However, the complete date is not present on the abstract. In order to clarify the publication date, the undersigned contacted Examiner Berman who located and faxed to the undersigned the actual article upon which the abstract was based. A study of the article also failed to turn up a publication date other than 1997.

The parent of the present application was filed on November 23, 1998, based on a foreign Japanese priority application filed on March 30, 1997. The parent application grew out of a PCT application and submitted with the original parent application was a PCT/1B/308 form showing that the applicant had a priority date of 30 March 1997.

Also accompanying the parent application was a declaration executed by Mr. Toshihiko Takano indicating that the application in English was a true translation of the international patent application No. PCT/JP98/01420. In addition, Form PCT/1B/304 which was filed with the parent application indicates a date of receipt of the priority document of May 1, 1998. In addition, applicants filed with the parent application a claim for priority claiming the priority of Japanese patent application No. 9-95307 filed March 30, 1997.

On the basis of these documents of record in this case, it is respectfully submitted that applicants have completed its claim for priority with respect to the subject matter of the Japanese parent case and that applicants have established a priority date of March 30, 1997 with certainty.

It is respectfully submitted that the abstract article of Egawa, et al. relied upon by the Examiner is clearly not prior in time to the applicants' Japanese priority document and, in addition, it was written by the inventors of the present application as well as several other persons.

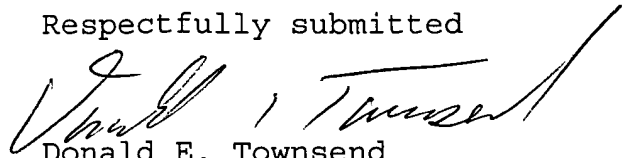
In view of the foregoing, it is respectfully submitted that the rejection of Claims 11 and 17-19 based on the '806 in view of Egawa, et al. fails as a matter of law because the Egawa, et al. reference is not prior art against this application. For this reason, it is respectfully submitted that the Examiner would be warranted in withdrawing this rejection. Withdrawal of the rejection is accordingly respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and early action and allowance thereof is accordingly respectfully requested.

If there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

DOCKET NO. TOS-125-USA-PCT

Respectfully submitted

A handwritten signature in dark ink, appearing to read 'Donald E. Townsend', is written over the typed name.

Donald E. Townsend
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Date: July 23, 2001

MARKED-UP VERSION OF AMENDED CLAIM 17

Please substitute the amended Claim 17 for the original Claim 17.

17. (Amended) A method of preventing environmental stress due to exposure of skin to automobile exhaust gases [by suppressing ultraweak chemiluminescence from the skin], comprising applying to the skin a liniment comprising thiotaurine [or hypotaurine].